

REMARKS

The Examiner rejects newly presented claims 6-9 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically the Examiner states that the claims contain subject matter that is not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention. As an example the Examiner states that the claims commonly recite the limitation of “*generic decoder to convert coded data at an input into decoded data at an output*” and “*a specific function of the generic decoder is overlaid with a corresponding function of the specific decoder so that corresponding function is interpreted by the generic decoder.*” The Examiner finds no support for the above claimed limitation or its description in the familiar terms of the specification.

Applicant states at page 1, lines 18-21 that protocol testers “require a decoding device that allows the protocol testers to apply the particular communication rules to the data picked up or received at a terminal unit so as to decode the data for further processing.” As is well known to one of ordinary skill in the art, a decoding device receives encoded data (according to the particular communication rules) and “decodes the (coded) data”, i.e., converts the coded data to decoded data. The drawing Figures all show “CODED DATA” at an input and “DECODED DATA” at an output. Applicant submits that the language used in the submitted claims, i.e., “to convert”, is merely descriptive of what happens in a decoding device in order to change or decode “coded data” at an input to “decoded data” at an output. Therefore there is ample support in the specification for the phrase “to convert”. However Applicant has amended claims 6 and 8 to recite “to decode” rather than “to convert” to exactly track the language in the specification. Applicant submits that such an amendment only goes to form rather than substance, as the two terms are deemed to be interchangeable -- “decoding” does “convert” or change the coded data at the input to decoded data at the output

Applicant further states at page 5, lines 1-5 that the “*generic decoder 24 has element functions, func_x, that are overlaid by corresponding element functions of the specific decoder 26 for protocol X*” so that during “*operation of the decoding device 14 the overlaid element functions may be interpreted by the generic device 24.*” Applicant has amended claims 6 and 8 to more closely track this language of the specification by reciting “wherein an element function

of the generic decoder is overlaid by a corresponding *element function* of the specific decoder.” Applicant submits that this amendment also only goes to form rather than substance, as one of ordinary skill in the art who has read the specification would readily understand that Applicant had possession of the claimed invention at the time of filing. Thus claims 6 and 8 together with claims 7 and 9 dependent therefrom are deemed to be allowable as being supported by the written description.

Applicant submits that these claims merely replace the original claims 1-5, covering the same substance, so that the arguments made previously regarding the prior art asserted by the Examiner against claims 1-5 are equally pertinent to claims 6-9, as presented in the prior response. Thus claims 6-9 are deemed to be allowable over the prior art previously cited by the Examiner.

In view of the foregoing amendment and remarks, entry of this amendment and allowance of claims 6-9 are urged, and such action and the issuance of this case are requested. Should the Examiner maintain the rejection of claims 6-9, entry of this amendment is requested as placing this case in better form for appeal without requiring any additional searching on the part of the Examiner as no substantive changes are made.

Respectfully submitted,
Wolfgang Bartsch

By: /Michael A. Nelson/

Michael A. Nelson
Reg. No. 59,450
(503) 627-1785 (Voice)
(503) 627-7119 (Fax)

May 9, 2008

Tektronix, Inc.
P.O. Box 500, Delivery Station 50-LAW
Beaverton, OR 97077
Attorney's Docket No. 7108-US